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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,980	10/08/2003	Werner Knebel	5005.1061	6488
23280	7590	05/02/2006		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			EXAMINER FINEMAN, LEE A	
			ART UNIT 2872	PAPER NUMBER

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/680,980

Applicant(s)

KNEBEL, WERNER

Examiner

Lee Fineman

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2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 8-11, 13-17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 January 2006 has been entered in which claim 1 has been amended and claim 6 has been cancelled. Claims 1-5 and 7-18 are pending of which claims 3-5, 7 and 12 are withdrawn.

**NOTE:** although claim 18 was labeled "(new)," it is clearly previously presented as evidenced by the last submission (filed 1 September 2005) and will be treated as such. However, applicant is reminded that the status identifier of each claim must be included and accurate or the amendment can be held as non-compliant.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 10-11, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lombardo, US 5,280,378.

Regarding claim 1, Lombardo discloses in fig 1 a scanning microscope comprising: a light source (28) that emits an illuminating light beam (part of 32), for illumination of a sample (18), that extends along an illumination beam path (fig. 1) and can be guided over the sample (18) using a beam deflection device (24); a detector (eye) that receives detection light (fig. 1), proceeding from the sample (18), that extends along a detection beam path (fig. 1); a light source (26) that emits a manipulating light beam (part of 32); and a mirror (unnumbered) which can be introduced in guided fashion into the illumination beam path (fig. 1, at least in so far as it was guided into place during assembly), whereby the mirror directs the manipulating light beam via the beam deflection device onto the sample (fig. 1); and wherein the manipulating light beam (from 26) can be guided over the sample (18) using the beam deflection device (24).

Regarding claims 10-11 and 13, Lombardo further discloses wherein the illuminating light beam (from 28) and the manipulating light beam (from 26) can be guided on a scanning track (by 24) over and/or through the sample (18); and wherein the scanning track is largely meander-shaped or sinusoidal (see fig. 7).

Regarding claim 15, Lombardo further discloses wherein the manipulating light beam (from 26) cuts the sample (see at least column 2, lines 6-10).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable Lombardo in view of Batchelder et al. US 5,689,333.

Lombardo discloses the claimed invention except for wherein the mirror is a hinged mirror and wherein the mirror can be put in a neutral position out of the illuminating beam path. Batchelder et al. teach in fig. 1 a microscope with mirrors (46, 74 or 76) which move in and out of the beam path to direct light in the system, i.e., wherein the mirror can be put in a neutral position out of the illuminating beam path, (column 2, lines 54-57 and column 4, lines 22-23) and which can be hinged (column 4, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the mirror of Lombardo a hinged mirror which moves in and out of the beam path as suggested by Batchelder et al. to permit ordinary use of the system without the second light beam (Batchelder, column 2, lines 54-57) which would further prevent accidental damage to the sample.

6. Claims 8-9, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable Lombardo in view of Knebel et al. US 2002/0020800 A1.

Regarding claim 17, Lombardo discloses the claimed invention except for wherein the scanning microscope is a confocal scanning microscope. Knebel et al. teaches a confocal scanning microscope (page 5, section [0056]) comprising a light source (3 and 4) that emits an illuminating light beam (on 5), for illumination of a sample (1), that extends along an illumination beam path (5) and can be guided over and/or through the sample (1) using a beam deflection device (12); a detector (6) that receives detection light (on 7), proceeding from the sample (1), that extends along a detection beam path (7); and a light source (8) that emits a

manipulating light beam (on 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the microscope of Lombardo a confocal scanning microscope as taught by Knebel et al. to provide better depth resolution and three-dimensional visualization of the sample (Knebel, page 5, section [0023]).

Regarding claims 14 and 16, Lombardo discloses the claimed invention except for wherein the manipulating light beam at least partially bleaches the sample or wherein the manipulating light beam acts as an optical tweezers. Knebel et al. further teaches wherein a scanning microscope with a illumination light beam and a manipulation light beam can provide different manipulation functions like wherein the manipulating light beam at least partially bleaches the sample (page 2, section [0023], lines 18-19); and wherein the manipulating light beam acts as an optical tweezers (page 2, section [0023], lines 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the manipulation beam of Lombardo be able to bleach the sample or act as optical tweezers as taught by Knebel et al. to provide a more flexible system that can further manipulate the sample in different ways.

Regarding claims 8-9, Lombardo further discloses wherein the illuminating light beam (from 28) and the manipulating light beam (from 26) can be guided together over and/or through the sample using the beam deflection device (24). Lombardo discloses the claimed invention except for wherein the mirror is at least partially transparent to the illuminating light beam (the mirror, unnumbered, is partially transparent to the manipulating light beam, see fig. 1). Knebel et al. further teaches a configuration (fig. 2) wherein a mirror (21) is at least partially transparent to the illuminating light beam (page 5, section [0059], lines 3-7) to combine the illuminating light

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beam and the manipulating light beam. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the mirror of Lombardo at least partially transparent to the illuminating light beam as taught by Knebel et al. to be able to provide different apparatus configurations for different sizing the apparatus.

### *Response to Arguments*

7. Applicant's arguments with respect to claims 1-2, 8-11, 13-17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

8. It is noted by the Examiner that the claim objection made in the previous Office Action have been withdrawn due to amendment by the Applicant.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LAF

April 24, 2006

  
MARK A. ROBINSON  
PRIMARY EXAMINER